

REMARKS

Claims 1-8 and 16-25 are pending in the application and stand rejected.

Claim Rejections - 35 U.S.C. § 112, Second Paragraph

Claims 5-7, 20-22 and 24-25 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite.

Specifically, the Examiner notes the terms “the paper”, “the paper base”, and “the paper sheet” are unclear.

In response, Applicants submit the present amendments to claims 5-7, 20-22 and 24-25 obviate this rejection.

Claim Rejections - 35 U.S.C. § 103(a)

Claims 1-4, 8, 17-19 and 23-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hughes (US 6,169,266) in view of Bowen (US 3,909,582) and Sonobe (US 6,244,176).

In the rejection, the Examiner contends Hughes discloses most of the features recited in claim 1. In particular, the Examiner contends Hughes discloses irradiating a beam on a front face of a material having a colored layer (FIG. 5B), a film layer (11:55-65), and a backing layer (FIG. 3, item 22).

The Examiner concedes that Hughes fails to disclose a paper sheet and that the ink or paint is a resin.

To provide these features, the Examiner applies Bowen alleging it discloses a multilayer laminate package which may include paper. (*Office Action*, p. 3, citing Bowen 1:10-16; 1:39-45; 6:62; and 6:57-60). As a reason to combine, the Examiner alleges that the paper material of Bowen would provide a reinforcing layer to the invention of Hughes.

Claim 1 recites, *inter alia*, irradiating a laser beam on a front face of a packaging case produced by a paper sheet base layer having a colored layer constituted by a coloring agent between a resin film layer which protects the front face on the front face, and the paper sheet base layer; and

evaporating the colored layer and the resin film layer by the laser beam to expose the paper sheet base layer and thereby forming the display on said packaging case,

wherein the display is formed by a contrast in color between the coloring agent and the exposed paper sheet.

In response, Applicants submit that even if combined as suggested, the suggested combination fails to disclose “wherein the display is formed by a contrast in color between the coloring agent and the exposed paper sheet,” as recited in claim 1. Notably, Hughes cautions that while a complete removal of the undercoat layer 24 in a small portion of the etched areas may be acceptable, if too much of the cover’s surface is exposed, an unwanted loss of the desired level of contrast can result. (8:25-29). As such, Hughes does not disclose removing all of the undercoat layer 24 as a means to create a display. Rather, Hughes teaches that a full removal of the undercoat layer 24 may damage the appearance of the display by reducing the contrast. (8:40-46). Thus, Hughes teaches away from removing all of the undercoat 24 to create a display. Instead, Hughes relies on the contrast created between the undercoat 24 and other layers.

Accordingly, because Hughes teaches away from intentionally removing all of the undercoat layer 24 to prevent a reduction in contrast, even if Hughes, Bowen and Sonobe are combined as suggested, they fail to teach “evaporating the colored layer and the resin film layer by the laser beam to expose the paper sheet base layer and thereby forming the display on said packaging case, wherein the display is formed by a contrast in color between the coloring agent

and the exposed paper sheet,” as recited in claim 1. Rather, Hughes teaches that the contrast is created by selecting the undercoat layer 24 and the overcoat layer 26 of colors having sufficient contrast.

Accordingly, Applicants submit that even if Hughes, Sonobe and Bowen could be combined as suggested, the applied combination fails to disclose “evaporating the colored layer and the resin film layer by the laser beam to expose the paper sheet and thereby forming the display on said packaging case,” as recited in claim 1.

Thus, Applicants submit claim 1 is allowable for at least those reasons set forth above. Additionally, because claim 18 recites a similar feature, it is submitted that claim 18 is allowable for the same reasons. Finally, it is submitted that claims 2-4, 8, 17, 19 and 23-25 are allowable, at least by virtue of their dependency.

Additionally, Applicants also note the Examiner provides a new justification/interpretation of the claimed features in the Response to Arguments section of the Office Action. Specifically, the Examiner alleges that the undercoat layer 24 may be interpreted part of the paper. As a premise for this argument, the Examiner contends that the wax paper commonly found in the kitchen is still described as paper. However, as expressly indicated by the Examiner, this is incorrect. Rather, wax paper is referred to as “wax” paper; not paper. Moreover, one of ordinary skill in the art would understand that the paper recited in claim 1 is not a wax paper. Rather claim 1 specifically recites “a packaging case produced by a paper sheet.”

Further, both Sonobe and Bowen distinguish the layers disposed on a paper from the paper itself. Specifically, Sonobe consistently discloses that the inks of four colors are applied to a printing paper sheet 56. The inks are addressed separately and distinct from the printing paper

sheet 56. Additionally, Bowen explicitly distinguishes the layers of a polymeric material from a paper material. Specifically, Bowen provides:

For example, the laminate may be comprises of layers of materials of each class such as paper, thermoplastic or foil. The laminates generally include at least one layer that is polymeric. (7:2-6).

As examples of such combinations of layers, the overlying layer or layers can be paper . . . and the underlying layers can be polypropylene. (9:56-60).

It is noted that the paper is considered as a separate layer from the polypropylene layer deposited thereon.

Accordingly, considering the prior art applied by the Examiner, there is no basis for interpreting any resin or ink coated on the paper as being a part of the paper. The art relied on by the Examiner clearly demarcates between the paper itself, and those ink or other layers coated on the paper. Consequently, Applicants submit the Examiner's interpretation is wholly unsupported and invalid.

As such, Applicants submit that because it is improper to assert that Hughes' undercoat layer 24 is part of the paper, the applied combination fails to disclose all the feature recited in claims 1 and 18.

Claim Rejections - 35 U.S.C. § 103(a)

Claims 5-7 and 20-22 stand rejected as being unpatentable over Hughes, Bowen and Sonobe as applied to claims 1 and 18, in further view of Ward (US 2,192,423).

In response, Applicants submit that because Ward fails to compensate for the above noted deficiencies of Hughes, Bowen and Sonobe as applied above, claims 5-7 and 20-22 are allowable, at least by virtue of their dependencies.

New Claims

New claims 26 and 27 are hereby added by this Amendment. These claims are supported, at least, by page 17 of the present specification. These claims are allowable because the applied prior art fails to disclose the features recited therein.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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